

**REMARKS**

Claims 1, 5, 6, 8-12, 15, 16, and 21-23 are all of the claims presently pending in the application. Applicants have canceled claims 7, 13, 14, 17, 19, and 20 without prejudice or disclaimer. Applicants have amended claims 1, 8, 9, 12, 18, and 23 to define the claimed invention more particularly. Applicants have added new claim 24 to claim additional features of the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 4-9, 12-14 and 17-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by Uchida (U.S. Patent No. 6,897,430). Claims 10, 11, 15, and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Uchida in view of Verdiell (U.S. Patent Application Publication No. 2001/0017376 A1).

Applicants respectfully traverse these rejections in the following discussion.

**I. THE CLAIMED INVENTION**

The claimed invention of exemplary claim 1, provides an optoelectronic hybrid integrated module wherein the optical device and the input/output IC are flip-chip mounted on a surface of the transparent base material substantially aligned with the light coupling means (e.g., see Application at Figure 1, page 4, line 25 through page 5, line 11, and page 10, lines 12-25). This allows the number of components and processes of the module to be reduced so that mounting costs can be suppressed (e.g., see Application at page 5, lines 20-23).

## II. PRIOR ART REFERENCES

### A. The Uchida Reference

The Examiner alleges that Uchida teaches the claimed invention of claims 1, 4-9, 12-14 and 17-23. Applicants, however, respectfully submit that Uchida does not teach or suggest every feature of the claimed invention.

That is, Uchida does not teach or suggest, “*wherein the optical device and the input/output IC are flip-chip mounted on the transparent base material substantially aligned with the light coupling means*”, as recited in exemplary claim 1 and similarly recited in claim 12.

The Examiner attempts to rely on Figures 3 and 4 (and the corresponding text) of Uchida to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Uchida teach or suggest that the optical device and the input/output IC are flip-chip mounted on a surface of the transparent base material substantially aligned with the light coupling means. Indeed, the Examiner has clearly misunderstood the teachings of Uchida.

Uchida does not teach or suggest that the light receiving part 1201 nor the light emitting part 1208 are flip-chip mounted. Indeed, as is clearly depicted in Figure 4 of Uchida neither the light receiving part 1201 nor the light emitting part 1208 are mounted on a surface of the substrate. Indeed, as indicated by the Examiner, the light receiving part 1201 and the light emitting part 1208 of Uchida are mounted within the substrate (see Office Action dated December 15, 2006 at page 3). Furthermore, neither the light receiving part 1201 nor the light emitting part 1208 are substantially aligned with the light coupling means.

Applicants further submit that Uchida does not even teach or suggest a light coupling means. The Examiner has attempted to also analogize the light receiving part 1201 and the

light emitting 1208 of Uchida to light coupling means. This is incorrect. That is, the light coupling means of the claimed invention is different component of the claimed invention than the input/output IC and the optical device.

Applicants submit that the in order to anticipate a claimed invention, “The identical invention must be shown in as complete detail as is contained in the ... claim.” (See M.P.E.P. § 2131; emphasis added). Uchida does not teach or suggest the exact structure recited in the claims.

Moreover, the Examiner alleges, on page 4, lines 17-20 of the Office Action, that, “Applicant has not defined the scope of the material having ‘high permeability to a wavelength of the optical device’ thus Uchida references (*sic*) reads upon the limitation since light is traveling through layer 1206, therefore, Uchida flexible transparent substrate (*sic*) has a high permeability to a wavelength of the optical device.”

Applicants submit, however, that when the optical device of the claimed invention serves as a light emitting device, light passes through the transparent base material in a direction almost (but not exactly) perpendicular to the surface of the base material, and then the light further passes through the oncoming coupling means to be outputted. In contrast, the light in Uchida travels along the surface of its transparent base material.

Therefore, Applicants respectfully submit that Uchida does not teach or suggest every feature of the claimed invention. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

#### **B. The Verdiell Reference**

The Examiner alleges that Verdiell would have been combined with Uchida to

teach the claimed invention of claims 10, 11, 15 and 16. Applicants respectfully submit, however, that, even if combined, the alleged combination of references would not teach or suggest every feature of the claimed invention.

That is, neither Verdiell nor Uchida, nor any combination thereof, teaches or suggests “*wherein the optical device and the input/output IC are flip-chip mounted on the transparent base material substantially aligned with the light coupling means*”, as recited in exemplary claim 1 and similarly claim 12.

Applicants respectfully submit that, as detailed in section A, above, Uchida does not teach or suggest this limitation. Furthermore, Applicants respectfully submit that Verdiell does not make up the deficiencies of Uchida.

That is, nowhere does Verdiell teach or suggest that the optical device and the input/output IC are flip-chip mounted on a surface of the transparent base material substantially aligned with the light coupling means. The Examiner does not even allege that Verdiell teaches or suggests this feature.

Thus, Verdiell fails to make up the deficiencies of Uchida.

Therefore, Applicants respectfully submit that, even if combined, the alleged combination of references would not teach or suggest every feature of the claimed invention. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

### **III. NEW CLAIM**

Applicants have added new claim 24 to claim additional features of the invention and to provide varied protection for the claimed invention. Applicants submit that new claim 24 is patentably distinct for the novel and nonobvious features recited therein.

New claim 24 is patentable over any combination of the cited references at least based on similar reasons to those set forth above with respect to claims 1, 5, 6, 8-12, 15, 16, and 21-23.

#### IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1, 5, 6, 8-12, 15, 16, and 21-24, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicants respectfully request the Examiner to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, Applicants respectfully request the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Applicants hereby authorize the Commissioner to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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